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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Satoshi Hoshino

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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08/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/899,075

Applicant(s)

HOSHINO, SATOSHI

Examiner

Jason M. Borlinghaus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/03/07 & 5/22/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Claims 1 – 8, 14 and 15 in the reply filed on 5/22/07 is acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 8 and 14 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kofune (US Patent 5,483,069) in view of Disclosed Prior Art (see pp. 1 – 2).

Regarding Claims 1 - 6, Disclosed Prior Art discloses an authenticity checker of a document (see abstract) comprising:

- an image capturing module (light sensor) for image capturing a watermark of a document from both obverse (via reflection on obverse side through reflection light sensor) and reverse side (via transmission from reverse side through transmission light sensor). (see fig. 6 – 7; col. 5, line 35 – col. 6, line 21);

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- said image captured according to an image capturing instruction (light sensors are controlled by data from the position detecting means). (see col. 5, line 35 – col. 6, line 21);
- a document image capturing controller (position detecting means) which outputs the image capturing instruction (data) to the document image capturing module at the beginning of the authenticity judging operation (prior to image capturing). (see fig. 7, col. 5, line 35 – col. 6, line 21);
- an authenticity judging module (CPU) which judges the document is a forgery if neither of the watermarks image captured from the obverse nor reverse side by the document image capturing module is recognized as a regular watermark, and judges the document is authentic if at least one of watermarks is recognized as a regular watermark (data outputted from both sensors are compared by a CPU). (see col. 1, lines 16 – 22; col. 5, line 35 – col. 6, line 21);
- first and second cameras (light sensors) to shoot the document. (see fig. 6 – 7; col. 5, line 35 – col. 6, line 21);
- first (reflection light emitter) and second (transmitted light emitter) to irradiate the document from the reverse and obverse side. (see fig. 6 – 7; col. 5, line 35 – col. 6, line 21); and
- a revolving means (conveying means) for revolving (placing) the document between the lens (transmitted light detector) and the light

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(transmitted light emitter) so that the backside of the document is placed opposite to the lens. (see fig. 6 – 7; col. 5, line 35 – col. 6, line 21).

Kofune does not teach an authenticity checker that checks a driver's license; nor first and second cameras to shoot the driver's license from the obverse and reverse sides, although Kofune does disclose first and second cameras to shoot watermarks contained on the obverse and reverse sides. (emphasis added).

Disclosed Prior Art discloses an authenticity checker of a driver's license (see p. 1, lines 15 – 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kofune by incorporating the ability to judge the authenticity of driver's licenses, as disclosed by Disclosed Prior Art, thereby incorporating the speed, efficiency and uniformity of an automated system to judge the authenticity of driver's licenses.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kofune and Disclosed Prior Art to have multiple cameras to capture images from the obverse and reverse sides of a driver's license, as a driver's license is a two-dimensional document having an obverse and reverse side requiring authentication.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have multiple cameras and multiple light sources to capture images of multiple sides or multiple angles of a two-sided document, since it has been held that mere duplication of the essential working parts of a device, without

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more, involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co*, 193 USPQ 8 (CA 7); *In re Harza*, 124 USPQ 378 (CCPA 1960).

Regarding Claims 7 – 8 and 14 - 15, such claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection. However, Examiner shall address Applicant's arguments filed 1/03/2007 nonetheless that may be pertinent to the elected claims.

Disclosed Prior Art

In response to the Applicant's argument that the specification does not constitute Disclosed Prior Art, the MPEP states that when "the specification's background of the invention describes information as being known or conventional, [it] may be considered as an admission of prior art." see *MPEP § 704.11 (a)*. Additionally, statements made by an Applicant for a patent, whether in the application or in other papers submitted during prosecution, that certain matters are "prior art" to him, is an admission that such matter is prior art. The valid prior art created by the admissions can be used for any purpose

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including use as evidence of obviousness, whether or not a basis in 35 U.S.C. 102 can be found for its use as prior art. *Aktiebolaget Karlstads Mekaniska Werkstad v. USITC*, 705 F.2d 1565, 217 USPQ 865 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982); and *In re Nomiya*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). To that end, the background does utilize terminology that indicates the disclosed information is known or conventional. Therefore, Examiner asserts that information contained within the specification under the title "Background of the Invention" is an admission of prior art and, therefore, Disclosed Prior Art.

Specifically, Disclosed Prior Art discloses "[c]onventional devices of the sort judge the authenticity of a driver's license based on image data of its watermark obtained by shooting the obverse of the driver's license as irradiating the license from the backside." (emphasis added, see p. 1, lines 15 – 18). Disclosed Prior Art even identifies existing patent applications that embody such conventional devices, such as Japanese Patent Application No. HEI11-66273.

In the Office Action mailed 10/02/06, Examiner mapped the claim language to the Disclosed Prior Art and, without a traversal specifically identifying the claimed features not taught by the Disclosed Prior Art, Examiner is uncertain what claimed features Applicant is asserting are not taught by Disclosed Prior Art.

Examining Document from Both Sides

In response to Applicant's argument that Examiner failed to produce prior art establishing that "[e]xamining a document and/or identification from both sides, either

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via manual or automated system, is old and well known in the art of authentication and verification," such statement by the Examiner was intended as a motivation for the recombination of existing elements in the prior art and not as a prior art reference in and of itself.

As driver's licenses are two-dimensional documents comprising a first side and a second side, judging the authenticity of such a two-dimensional document would naturally consist of analysis of the first side and the second side. Motivation for the alteration of the prior art reference is dictated by the very nature of the driver's license itself, as a document having two sides requiring examination of both.

Motivation

In response to applicant's argument that there is no suggestion to combine the references within the cited prior art references themselves, the Courts have stated that "[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references...The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 78 USPQ2d 1329, 1336 (CAFC 2006). Examiner asserts that

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he can and/or has provided such "articulated reasoning" to support the legal conclusion of obviousness.

Duplication

In response to the Applicant's argument that Examiner misapplied the St. Regis Paper and *In re Harza*, Examiner refutes such an allegation.

In re Harza dealt with a patent application in which "[t]he only distinction to be found is in the recitation in claim 1 of a plurality of ribs on each side of the web whereas [prior art reference] Gardner shows only a single rib on each side of the web. It is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced." *In re Harza*, 124 USPQ 378, 380 (CCPA 1960).

In the instant application, multiple cameras and multiple light sources are being utilized while the prior art reference disclosed a single camera and a single light source being utilized. The result of multiple cameras and multiple light sources provides the expected result of capturing images from multiple cameras lighted by multiple light sources from multiple angles. When such an expected result is considered in conjunction with

Claims 2, 4, 6 and 8

In response to applicant's argument that prior art reference(s) fail to disclose claim limitation(s), specifically that prior art reference(s) fail to disclose:

a driver's license shooting controller which outputs the shooting instruction to the driver's license shooting means at the beginning of the authenticity

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judging operation, and outputs the re-shooting instruction to the driver's license shooting means when the watermark shot from one side is not recognized as a regular watermark

Examiner refutes such an assertion as such definition of claim terminology was not articulated in the original specification nor utilized in the previously presented claim(s). As such, the broadest definition for the term was applied as to provide the "broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims." *See In re Prater and Wei, 162 USPQ 541, 550 (CCPA 1969).*

A conventional device that shoots the obverse side of a driver's license, as cited on p. 1, lines 15 – 18, must inherently have some controller that outputs shooting instructions, otherwise the conventional device randomly, spontaneously and/or spastically takes pictures without any form of control. "Controller" is not defined and could be a person, a push-button on a camera or a computer.

Such instructions come at the beginning of the authenticity judging operation. However, as what the "beginning of the authenticity judging operation" entails is not defined, Examiner assumes that utilization of the conventional device is the beginning of the operation.

Outputting re-shooting instructions to the shooting means is once again mere duplication or repetition of prior established steps falling under *In re Harza*.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMB

August 6, 2007

 8-6-07
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